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10/728,086	12/05/2003	Kevin Neil Kim	MFCP.108796	7301
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SHOOK, HARDY & BACON L.L.P. 2555 GRAND BOULEVARD KANSAS CITY, MO 64108-2613			WOODS, ERIC V	
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DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/728,086	<b>Applicant(s)</b> KIRN ET AL.	
	<b>Examiner</b> Eric V. Woods	<b>Art Unit</b> 2672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

*By*

## **DETAILED ACTION**

### ***Response to Amendment***

The affidavits and evidence filed on 7 July 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Biggs reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Biggs reference to either a constructive reduction to practice or an actual reduction to practice.

While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

The declaration under 37 CFR 1.131 filed 7 July 2005 is insufficient to overcome the rejection of claims 1-26 over Curry in view of Biggs under 35 USC § 103(a) as set forth in the last Office action on 19 April 2005 because it fails to establish reduction to practice prior to the date of the reference.

#### **I. Formalities.**

All inventors have signed the various affidavits, and the affidavits do indicated conception and/or RTP in the United States, a NAFTA country, and/or a WTO member state.

#### **II. Analysis**

The affidavits will now be analyzed for sufficiency and compliance with the appropriate rules, and their collective deficiencies will be noted.

Paragraphs 1-2 merely establish inventorship and residency.

Paragraph 3 states that the declarant has reviewed the references (and presumably the Office Action).

Paragraph 4 satisfies formalities concerning the subject matter not being subject to estoppel or interference.

The next paragraph on page 1 opens with a conclusory statement that such inventions were conceived and reduced to practice prior to the filing date of the Curry and/or Biggs applications.

The assertion that the applicant was in possession of the invention of all claims of the application and had reduced such to practice prior to a certain date (and the fourth item asserts that applicant had reduced such invention to practice by an earlier date (July 3, 2001). Those statements are **CONCLUSORY** statements, **NOT** facts.

MPEP 715.07 clearly states:

"The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. For example, submitting as evidence one or more of the following might support the allegations of fact:

(D) – Attached reproductions of laboratory notebook entries;

(F) –Attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon;

-Drawings and the like.

Applicant does not explain the attached document, nor does applicant provide any determination of **how** such documents fulfill any of the requirements under 37 CFR 1.131.

Examiner next notes that there are three ways to overcome a reference, as per MPEP 715.07, subsection III.

As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

(A) Reduction to practice of the invention prior to the effective date of the reference; or

(B) Conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a **subsequent (actual) reduction to practice**; or

(C) Conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (**constructive reduction to practice**).

Applicant appears to be choosing option A or B, although this is never explicitly stated.

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Note MPEP 715.07.

A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. Automatic Weighing Mach. Co. v. Pneumatic Scale Corp., 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909).

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In Mergenthaler v. Scudder, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, "there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice." In re Asahi/America Inc., \*\*>68 F.3d 442, 37 USPQ2d 1204, 1206< (Fed. Cir. 1995) (Citing Newkirk v. \*>Lulejian<, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and Sachs v. Wadsworth, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

Various evidence is listed as an **attachment** to the affidavit, which is insufficient by itself. 37 CFR 1.131(b) states *inter alia* "...Original exhibits of drawings and records ... must accompany **and form part of the affidavit or declaration or their absence satisfactorily explained** (emphasis added). What the Remarks term as Appendix A merely sets forth that such documentation is attached to the affidavit but not incorporated. Therefore, as stated above, the affidavit **FAILS** to comply with the requirement.

A written description does not constitute an actual reduction to practice.

Furthermore, only the filing of a US patent application that complies with the disclosure

requirement of 35 USC § 112 constitutes a constructive reduction to practice. A written description, no matter how complete, does not qualify as an actual reduction to practice.

Examiner points out that the attached documents would – under the most generous possible interpretation – only serve to prove conception. There is nothing establishing actual reduction to practice or diligence between conception and actual or constructive reduction to practice.

The affidavits never utilize the terms “reduction to practice” or “conception”. Further, as stated above, a brief sketch of requirements of a system does not in fact prove anything, because partial requirements do not prove conception, and there is no indication of any experimentation, structural data, software code, high level code layouts, or anything other than a mental idea and some scenarios.

Indeed, the enclosed document merely states prima facie on page 1 “This doc is a *very rough cut* at integration ... We’re just exploring at this point.” That states no more than conception.

Finally, examiner points out that the document is not dated. Therefore, there is no indication that it is actually predates the filing of the instant application. There must be **some** evidence that such documents were created prior to the filing of the application. Otherwise such assertions are conclusory and not statements of fact.

### III. Conclusion

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Biggs or Curry references to either a constructive reduction to practice or an actual reduction to practice. Applicant has not shown

sufficiently that diligence was practiced between the time periods asserted. There is only evidence that purports that the inventor had some portion of the invention in the time period before the references were filed. There is no timeline explaining applicant's actions between the document and the filing of the actual instant application. By the very definition of diligence, applicant must have performed some actions to see that the invention was prosecuted as a patent. There is no evidence -- at least proffered -- that applicant did anything for that period between conception and the filing of the actual application, and examiner cannot conclude that diligence was in fact existent with respect to this invention. The lack and dearth of evidence detailing applicant's actions over that time simply does not meet the required legal tests.

The affidavit merely recites **conclusory statements**. There is **no actual evidence or explanation of reduction to practice**. The insertion of such explanation in the **Remarks** is not sufficient -- that explanation and all details **must** be in the **affidavit itself**, not in **attached comments or Remarks**. As such, the affidavits are insufficient. Examiner points out that while normally the burden of proof is on the Office (e.g. questions of definiteness, obviousness, and the like), in the case of affidavits under 37 CFR 1.131 the burden of proof is on applicant and the Office serves in the role of trying facts. In this case, there are no facts sworn to, only conclusory statements, and the affidavits are therefore held insufficient.

Also, there was never any evidence of testing or the existence of a prototype.

Proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.



The cited information does not purport to disclose a test apparatus that would be a prototype of the independent claims. Further, in order for such evidence to be accepted (even if it were present) applicant would have to provide enough detail such that examiner could determine:

- Which of the claim limitations are satisfied by the prototype (or the allegedly sufficient written description)
- What test conditions were used and if they represented actual conditions or realistically simulated ones
- And whether or not the test results demonstrated that the test was successful and reproducible. (See MPEP 608.01(p), subsection II – “Simulated or Predicted test results” and biomedical applications must show specific test data to prove the suitability and safety of a compound for a particular purpose (see MPEP 2105, section III for example) to establish utility.

No such test data was received or included.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Curry et al (US PGPub 2003/0172116 A1)('Curry') in view of Biggs et al (US 2004/0172451

A1)(‘Biggs’). (Claims 1 and 11 are similar, simply a method and apparatus for performing the same task)

As to claims 1 and 11,

A system for selectively presenting media embedded in a message, comprising:

- An input interface to receive a media-enabled message; (Curry Fig. 1, element 122, “email program”, see [0008-0010], communicated over network 106)(Biggs Fig. 2 – the “Recipients Browser” element 504 – and the “Pmail Recipient” 9 who retrieves the message using some kind of client program – see [0009-0014])
- A messaging client, communicating with the input interface, the messaging client presenting the media-enabled message to a user and permitting the user to select at least one media object in the media-enabled message; and (Curry Fig. 1, element 122, “email program”, see [0008-0010])(Biggs Fig. 2 – the “Recipients Browser” element 504 – and the “Pmail Recipient” 9 who retrieves the message using some kind of client program – see [0009-0014])
- A media player, communicating with the messaging client, the media player presenting an enhanced representation of the at least one media object to the user. (Biggs in the cited browser 504 in Fig. 2, where the browser accesses the “Pmail data store” 7 to allow the user to display the full-sized or enhanced image – [0014-0020])(Curry [0008-0012] wherein it is stated that the user can play the attached audio or video file retrieved from a streaming server, as shown in Fig. 1 where 114’, 114, and 114” represent locations for streaming servers on the network, where the multimedia content from the

sender or first client 102 is stored before being downloaded by second client 104—see [0030-0035])

Curry teaches all the limitations of the claim expressly except the 'enhanced representation' recited, given that Curry never states expressly that a detail of the message, e.g. some sort of thumbnail of a video or snippet of an audio message could be shown, whereas Biggs teaches that the user sees thumbnails of all available images and can choose which to download from a remote server, which clearly constitutes an "enhanced representation" which could be played back to a user. Further, it would be logical to assume that a video and/or audio clip could easily have a sample frame shown as a 'thumbnail' image as this technique is well-known in the art (Microsoft's File Explorer within various versions of Windows has this functionality, in that it will show a sample frame from a movie clip), and further that such a video clip or image could also have audio associated with it (indeed most video does). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the systems of Curry with that of Biggs for the aforementioned reasons and further because giving the user the ability to choose between clips – e.g. more easily select which attachment was desired – would allow the recipient of the email message to be more effective in determining which of the attachments was truly desired [0034, Curry], which also states that such embodiments can be web-based and also use embedded media players of the operating system or other functionality (Biggs [0012-0014]).

Curry teaches in Fig. 2A and in [0032-0033] that the message may contain a link indicating that the message has multimedia associated with it, particularly in [0034-

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0035], where it is disclosed that such links may be URLs within a browser to activate a location on a server, e.g. the streaming servers 114, 114', and 114'' in Fig. 1. Biggs also teaches HTML links in [0010], [0015-0017] and others so that the user can access the enhanced-resolution version of the thumbnail on the remote server.

As to claim 11, the only difference from claim 1 is slightly semantic, wherein letting the receiver select the desired object is set out as a separate step. This step is clearly taught by Biggs in [0011] where it is stated that the user is presented with a variety of thumbnails. The user must prima facie choose an image by clicking upon it to activate the HTML link in order to see the enhanced-resolution version; the same logic holds for the situation of the HTML links in Curry. Thusly, motivation / combination is the same as that of claim 1.

As to claims 2 and 12, Curry teaches email in [0008-0012] and Biggs teaches email in [0010] and [0015-0017], where emails are sent and received respectively. Motivation and combination is taken from claim 1.

As to claims 3, Curry teaches email programs in [0001-0004] and Biggs teaches email clients in [0002] and further details of email programs in general in, for example [0011] and [0016-0017]. Any email program is prima facie an email client if it allows the user to receive and send email as those recited programs do. Motivation and combination is taken from claim 1.

As to claims 4 and 13, Curry teaches media objects that are audio streams and video streams attached to emails, as in [0005] and particularly [0008-0010] where such is embedded in the program. Further, in [0028] Curry discloses that such emails may

include images, and Biggs teaches in [0010-0016] the use of images in email with the sending of the thumbnails. Motivation and combination is taken from claim 1.

As to claims 5 and 14, Curry does not expressly teach this limitation, but does teach that emails can include images in [0028], whereas Biggs explicitly teaches this limitation in [0010-0017] where it is disclosed that the email contains thumbnail images and the user can, using a browser or other embedded application, access an enhanced-resolution version of the image, e.g. a typical resolution of 100x75 for thumbnails and 640x480 for "enhanced resolution" [0011-0012]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the systems of Curry and Biggs, and the motivation and combination are incorporated from the rejection of the parent claim by reference.

As to claim 6, Curry expressly teaches that the media playing capabilities of his player include audio and video [0008-0010]. Since only the primary reference is utilized, no separate motivation or combination is required and that from the rejection to the parent claim is herein incorporated by reference.

As to claims 7 and 15, Curry teaches in Fig. 2A and in [0032-0033] that the message may contain a link indicating that the message has multimedia associated with it, particularly in [0034-0035], where it is disclosed that such links may be URLs within a browser to activate a location on a server, e.g. the streaming servers 114, 114', and 114" in Fig. 1. Biggs also teaches HTML links in [0010], [0015-0017] and others so that the user can access the enhanced-resolution version of the thumbnail on the remote server. Motivation and combination is taken from claim 1.

As to claim 8, Curry clearly teaches in [0008-0011] that the media player is integrated with the messaging client. Motivation and combination is taken from claim 1.

As to claim 9, Curry clearly teaches that in [0033-0034] that external players can be used, e.g. Windows™ Media Player or QuickTime™ and that in certain embodiments those would be opened by clicking on a link that the browser program would then open and hand over to the media player (e.g. if the email were text only, and the link was opened by the browser automatically in response). Since only the primary reference is utilized, no separate motivation or combination is required and that from the rejection to the parent claim is herein incorporated by reference.

As to claims 10 and 16, Curry expressly teaches this limitation, as he teaches retrieving multimedia from the server, and given that images can be links within HTML, and Curry teaches images in [0028], that would be an obvious variant. Biggs does expressly teach this limitation in [0016-0018] where the user must go to the website to retrieve the enhanced-resolution version. Specifically, the client of Curry that receives the email then communicates with the streaming server [0008-0009] to obtain the audio or video when the user activates the link. Motivation and combination is taken from claim 1.

As to claims 17 and 22,

A system for generating a media-enabled message, comprising:

-A selector module, the selector module permitting a user to selectively embed at least one media object in a media-enabled message; (Biggs [0012-0013] wherein in [0034-0036], particularly [0035], it is taught that the user can create an email message and

select which pictures to upload to the central server and then provide thumbnails of)(Curry teaches that the user can choose at least one media object to embed within the email in [0008-0009]; further see Fig. 2A and 4A, where the multimedia is either embedded in or attached to the email respectively, and as can be seen in Fig. 7, the user has the option to "Select File" in the "Video Message Control Screen 706))

-An uploader module, communicating with the selector module, the uploader module publishing an enhanced representation of the at least one media object accessible to a recipient of the media-enabled message. (Uploader module exists in Curry in Fig. 2, element 206, where the media is uploaded to the server – see [0008-0012] again)(Biggs clearly teaches this limitation in [0009] and [0012-0013] where it is disclosed how these files are uploaded to the server and made smaller, e.g. see Fig. 2 wherein the Branded Client software 201 uploads the thumbnails and real images to Brand Pmail Server 5)

As stated in the rejection to claim 1 above, the Curry reference teaches all the limitations with respect to audio and video and the Biggs reference explicitly teaches images. Motivation and combination are taken from claim 1 and incorporated herein by reference in their entirety, with secondary motivation as stated in claim 1, wherein it would be an obvious and desirable variation for the user to be able to upload multiple objects with one messages, and it is known in the art that email programs allow multiple, if not unlimited, numbers of attachments, and further by generating the thumbnails from for example videos a user could ascertain more easily whether or not a video clip was desired (e.g. a video greeting card vs. various undesired videos of scenery that take up large amounts of space).

As to claims 18 and 23, these are substantial duplicates of claims 2 and 12; the rejection to those claims above is herein incorporated by reference in its entirety.

As to claims 19 and 24, these are substantial duplicates of claims 4 and 13; the rejection to those claims above is herein incorporated by reference in its entirety.

As to claims 20 and 25, these are substantial duplicates of claims 5 and 14; the rejection to those claims above is herein incorporated by reference in its entirety.

As to claims 21 and 26, these are substantial duplicates of claims 10 and 16; the rejection to those claims above is herein incorporated by reference in its entirety.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric V. Woods whose telephone number is 571-272-7775. The examiner can normally be reached on M-F 7:30-4:30 alternate Fridays off.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi can be reached on 571-272-7664. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eric Woods

August 22, 2005



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